

10/606,203 filed 06/25/2003
Wesley B. Dong
Reply to Office Action of 06/26/2006

REMARKS/ARGUMENTS

Claims 1–27 are pending in the above-captioned application. Claims 11–20 and 27 stand rejected, and claims 1–10 and 21–26 are withdrawn from consideration. With this paper, claims 11, 16, and 27 have been amended, and claims 1–10, 15, and 21–26 have been canceled. No new matter was added with the amendment.

I. Election/Restrictions

Applicant confirms having elected to prosecute the invention of Group II, claims 11–20 and 27. To simplify prosecution of this case, Applicant is canceling claims 1–10 and 21–26, while retaining the right to pursue those claims in a divisional application.

II. Claim rejections under 35 U.S.C. § 112, second paragraph

Claim 15 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Applicant has canceled claim 15.

III. Claim rejections under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. (5,587,321) in view of Coffman et al. (2001/0001644)

Claims 11–14 and 27 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Smith et al. (5,587,321) in view of Coffman et al. (2001/0001644). The rejection of these claims is respectfully traversed.

To warrant rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. See MPEP § 2142. At a minimum, neither Smith et al. nor Coffman et al. teaches first and second multiwell plates that have “the same general configuration” and are configured to be placed into a stacked configuration. The limitation that the first and second multiwell plates have “the same general configuration” has been added to claims 11 and 27 to more particularly point out and distinctly claim Applicant’s invention. Support for the limitation can be found on page 8, lines 9–11 of paragraph 0027. Further amendments to claim 11 simply emphasize that the two multiwell plates have the same general configuration, e.g., each multiwell plate has wells, a ridge, and a flange. Claim 16 has been

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amended only to be consistent with amended claim 11. Thus, no new matter has been added by the amendments to the claims.

At most, Smith et al. teach a first multiwell plate and a cover that are configured to be placed into a stacked configuration. The cover does not have the same general configuration as the first multiwell plate.

Coffman et al. teach first and second multiwell plates that do not have the same general configuration. This can be seen in Figures 1 and 2. Further, wells of the first (upper) multiwell plate have openings at the tops of the wells in addition to outlets in the bottoms of the wells that are arrayed to register with wells of the second (lower) multiwell plate. Thus, the first multiwell plate of Coffman et al. does not have "blind" wells such as are recited in Applicant's amended claims 11 and 27. The term "blind" has been added to claims 11 and 27 to emphasize that the wells of Applicant's multiwell plate have only one opening or outlet. Support for the limitation can be found on page 7, in line 3 of paragraph 0026, which defines wells as "blind" holes. Further, a "well" is understood by one of skill in the art to have a single opening or outlet unless an additional outlet is specified, as has been done by Coffman et al. in the abstract as well as throughout the reference.

Thus, combining the two cited references does not teach or suggest all of the limitations of either claim 11 or claim 27. Withdrawal of the rejection of these claims as being unpatentable over Smith et al. (5,587,321) in view of Coffman et al. (2001/0001644) is respectfully requested.

Claims 12–14 depend directly from amended independent claim 11. Any claim depending from a nonobvious claim is also nonobvious. See MPEP § 2143.03 and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 12–14 are nonobvious. Withdrawal of the rejection of these claims as being unpatentable over Smith et al. (5,587,321) in view of Coffman et al. (2001/0001644) is respectfully requested.

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IV. Claim rejections under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. (5,587,321) in view of Coffman et al. (2001/0001644) and further in view of Guhl et al. (4,657,876)

Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Smith et al. (5,587,321) in view of Coffman et al. (2001/0001644) as applied to claims 11–13 and 27 and further in view of Guhl et al. (4,657,876). This rejection is respectfully traversed.

As demonstrated above, Applicant's amended independent claim 11 is nonobvious. Claims 16 and 17 depend directly and indirectly, respectively, from claim 11. As any claim depending from a nonobvious claim is also nonobvious, dependent claims 16 and 17 are nonobvious. Withdrawal of the rejection of claims 16 and 17 as being unpatentable over Smith et al. (5,587,321) in view of Coffman et al. (2001/0001644) and further in view of Guhl et al. (4,657,876) is, therefore, respectfully requested.

V. Claim rejections under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. (5,587,321) in view of Coffman et al. (2001/0001644) and further in view of Inoue et al. (5,955,352)

Claims 18–20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Smith et al. (5,587,321) in view of Coffman et al. (2001/0001644) as applied to claims 11–13 and 27 and further in view of Inoue et al. (5,955,352). This rejection is respectfully traversed.

As demonstrated above, Applicant's amended independent claim 11 is nonobvious. Claims 18–20 depend directly or indirectly from claim 11. As any claim depending from a nonobvious claim is also nonobvious, dependent claims 18–20 are nonobvious. Withdrawal of the rejection of claims 18–20 as being unpatentable over Smith et al. (5,587,321) in view of Coffman et al. (2001/0001644) and further in view of Inoue et al. (5,955,352) is, therefore, respectfully requested.

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Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

Respectfully submitted,

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Signed: Ann C. Petersen